

### **REMARKS**

In the Final Office Action<sup>1</sup>, the Examiner:

rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending U.S. Patent Application no. 10/720,920 (the '920 application);

rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending U.S. Patent Application no. 10/858,973 (the '973 application);

rejected claims 1-4 and 7-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,390 to Abburi ("*Abburi*") in view of U.S. Patent No. 7,209,955 to Major et al. ("*Major*");

rejected claims 5, 6, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Abburi* in view of *Major* and further in view of U.S. Patent No. 6,628,194 to Hellebust et al. ("*Hellebust*"); and

rejected claims 1, 12, 15, and 19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2001/0012286 to Huna et al. ("*Huna*") in view of *Abburi*.

By the present amendment, Applicants have amended claims 1, 3, 8-12, 15, 16, 18, and 19, and added new claim 22. Claims 1-22 are pending in this application.

#### **I. Nonstatutory double patenting rejections of Claims 1-21**

In the Final Office Action the Examiner rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of the '920 application, and over claims 1-37 and 110 of the '973 application.

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<sup>1</sup> The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

(Final Office Action at pages 2-3). Applicants respectfully traverse the nonstatutory obviousness-type double patenting rejections of claim 1-21, and requests that the Examiner hold the rejections in abeyance. Both the '920 application and the '973 application are currently pending and, thus, no double patenting circumstances can arise until a patent is granted.

Applicants have previously pointed out that the double patenting rejection is improper, and that any double patenting rejection over the claims of copending applications should be a provisional double patenting rejection (See Amendment filed September 4, 2008 at pages 8-9 including footnote 2). However, the Final Office Action does not address this point and instead simply reiterates the double patenting rejection from the previous Office Action. Nevertheless, because any nonprovisional double patenting rejection would be improper at this time, Applicants respectfully that the double patenting rejections be held in abeyance and any resolution in the form of a Terminal Disclaimer or otherwise be deferred.

## **II. Rejection of Claims 1-4 and 7-19 under 35 U.S.C. § 103(a)**

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-4 and 7-19 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

Claim 1 recites a method comprising "receiving a user-specified phone number from which a user will receive notifications" and "transmitting [a] notification to the preferred device if the incoming data is determined to be from the user-specified phone number" (emphasis added).

*Abburi* discloses a system and method by which individuals can send or receive audio messages using telephone devices or computer devices (*Abburi*, abstract).

*Abburi* also discloses a “user profile” that specifies communication devices that should receive delivery or notification of messages intended for an individual recipient (*Abburi*, col. 2, lines 29-34). However, *Abburi* does not disclose that the profile includes phone numbers from which *Abburi*’s user wants to receive notifications. Therefore, *Abburi* does not teach or suggest “receiving a user-specified phone number from which a user will receive notifications” as recited by independent claim 1 (emphasis added).

Further, *Abburi* does not disclose that notifications are transmitted to the telephone or computer devices if the messages are from a phone number in the profile. Therefore, *Abburi* also does not teach or suggest “transmitting [a] notification to the preferred device if the incoming data is determined to be from the user-specified phone number” as recited by independent claim 1 (emphasis added).

*Major* fails to cure these deficiencies of *Abburi*. *Major* discloses a notification system and method for a mobile data communication device (*Major*, abstract). *Major* also discloses a “notification scheme” that provides a user with notification alerts such as audible or vibrating alerts (*Major*, col. 11, lines 49-51). However, while *Major* discloses the notification scheme can be “party-specific” (*Major*, col. 12, lines 6-8), *Major* does not disclose that the notification scheme includes specified phone numbers. Therefore, *Major* also does not teach or suggest “receiving a user-specified phone number from which a user will receive notifications” as recited by independent claim 1 (emphasis added).

Further, *Major* does not disclose that the notification scheme provides for transmitting notifications when the audible or vibrating alert is from a specified phone number. Therefore, *Major* also does not teach or suggest “transmitting [a] notification to the preferred device if the incoming data is determined to be from the user-specified phone number” as recited by independent claim 1 (emphasis added).

Accordingly, no *prima facie* case of obviousness has been established for independent claim 1. Independent claims 12, 15, and 19, while of different scope, recite features similar to those of claim 1 and are thus allowable over *Abburi* and *Major* for reasons similar to those discussed above in regard to claim 1. Claims 2-4, 7-11, 13, 14, and 16-18 are also allowable at least due to their dependence from one of the independent claims.

### **III. Rejection of Claims 5, 6, 20, and 21 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the Examiner’s rejection of claims 5, 6, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Abburi* and *Major* in view of *Hellebust*. A *prima facie* case of obviousness has not been established with respect to these claims.

Claims 5 and 6 depend from claim 1, and claims 20 and 21 depend from claim 19, and therefore include all of the subject matter recited in their respective base claims. Independent claim 19, although of different scope than claim 1, recite features similar to those set forth above with respect to claim 1. As discussed above with respect to claim 1, *Abburi* and *Major* fail to teach or suggest the claimed “receiving a user-specified phone number from which a user will receive notifications” and “transmitting [a]

notification to the preferred device if the incoming data is determined to be from the user-specified phone number" (emphasis added).

*Hellebust* fails to cure these deficiencies of *Abburi* and *Major*. *Hellebust* discloses configuring wireless devices to display the number of voice mails, e-mails, and Internet information alerts that are received during a selected time interval (*Hellebust*, abstract). *Hellebust* also discloses using predetermined rules to determine whether an incoming message is of sufficient priority to alert a user that the message has arrived (*Hellebust*, col. 3, lines 53-55). However, while *Hellebust* discloses classifying messages by the originator's email address (*Hellebust*, col. 4, lines 12-19), *Hellebust* does not disclose classifying the messages by a phone number. Therefore, *Hellebust* does not teach or suggest "receiving a user-specified phone number from which a user will receive notifications" or "transmitting [a] notification to the preferred device if the incoming data is determined to be from the user-specified phone number" as recited by independent claim 1 (emphasis added).

For these reasons, no *prima facie* case of obviousness has been established with respect to claims 5, 6, 20, and 21. Accordingly, Applicants request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 5, 6, 20, and 21.

#### **IV. Rejection of Claims 1, 12, 15, and 19 under 35 U.S.C. § 103(a)**

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 12, 15, and 19 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

*Huna* discloses an apparatus and method for alerting a user upon receipt of selected messages, independent of the type of device generating the message (*Huna*,

abstract). *Huna* also discloses that when a call is made from a device, a determination is made whether an alert should be provided based on “message type, or other criteria” (*Huna*, ¶ 83). However, *Huna* does not disclose that the criteria include a phone number. Therefore, *Huna* does not teach or suggest “receiving a user-specified phone number from which a user will receive notifications” or “transmitting [a] notification to the preferred device if the incoming data is determined to be from the user-specified phone number” as recited by independent claim 1 (emphasis added).

As discussed above with respect to the 35 U.S.C. § 103(a) rejection of claims 1-4 and 7-19, *Abburi* also fails to teach or suggest these recitations of independent claim 1. Accordingly, no *prima facie* case of obviousness has been established for independent claim 1. Independent claims 12, 15, and 19, while of different scope, recite features similar to those of claim 1 and are thus allowable over *Huna* and *Abburi* for reasons similar to those discussed above in regard to claim 1.

## **V. Conclusion**

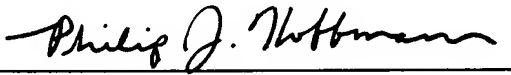
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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